

Express Mail Label No. EV 655365792 US  
Application No. 10/614,399  
Atty. Docket No. 4811-18

REMARKS/ARGUMENTS

Reconsideration and reexamination is requested in view of the above amendments to the claims and the following remarks. Claims 27, 30, 35 and 43 have been amended. New Claim 49 has been added. Support for the amendments and the new claim can be found in the specification, as originally filed, for example at Fig. 5; page 24, line 19 to page 25, line 15; and page 26, lines 5-19. Accordingly, Claims 27 and 29-49 are currently pending in this application.

1. Double Patenting Rejection

Claim 27 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 3, 9, 18, 20, 22, 28, 40, 46-48, and 54-57 of U.S. Patent No. 6,929,771 (“the ‘771 patent”). The ‘771 patent teaches a method for producing a molded article comprising: (a) providing a transfer having a flocking layer, a release sheet on one side of the flocking layer, and a layer of a permanent adhesive on an opposite side of the flocking layer to adhere the transfer to the molded article; (b) securing a release sheet to an interior wall of a mold by vacuum, release adhesive, or the like; and (c) molding an article from a resin such that the resin that contacts the layer of permanent adhesive does not liquefy and ooze out around the flock during the molding step. *See* Claim 1 and col. 2, line 53 to col. 3, line 34 of the ‘771 patent. The ‘771 patent however, is at least wholly silent as to forming the mold insert into a three-dimensional shape that substantially corresponds to a surface of at least a portion of a mold. In view of the above, Applicant requests that the double patenting rejections be withdrawn.

2. Claim 27

Applicant has amended Claim 27 to clarify that the method comprises forming the mold insert into a three-dimensional shape that substantially corresponds to a surface of at least a portion of a mold; positioning the mold insert in the mold; and while the mold insert is positioned in the mold, introducing a resin into the mold to form a molded article comprising resin and the mold

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insert, wherein the thermosettable adhesive film is thermoset before the introducing step. As the Examiner noted in the Office Action mailed October 19, 2005, “[t]he specification teaches thermosetting adhesive is at least partially and typically, fully activated (i.e. thermoset) before positioning the mold insert into a mold, so as to follow the contours of the mold.” *See also* page 16, lines 14-20; page 24, line 19 to page 25, line 15; and page 26, lines 7-19 discussing forming the mold insert into a three-dimensional shape that substantially corresponds to a surface of at least a portion of a mold; positioning the mold insert in the mold; and while the mold insert is positioned in the mold, introducing a resin into the mold to form a molded article comprising resin and the mold insert. In view of the above, Applicant requests that the rejections of Claim 27, and all claims dependent thereon, under 35 U.S.C. 112 be withdrawn.

#### Claim 34

Claim 34 was rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Claim 34 requires that the thermosetting adhesive layer and the backing film to be a cast and/or extruded, continuous film. The Examiner contends that while the specification teaches that the backing film is in the form of a cast or extruded continuous film on page 22, line 11, the specification does not clearly teach that the thermosetting adhesive layer is also. Applicant respectfully disagrees with the Examiner’s position.

First, the original specification of the present application, on page 6, line 18-19, incorporated by reference U.S. Application No. 09/621,830 (Attorney Docket No. 4811-9). U.S. Application No. 09/621,830, on page 3, lines 6-10, for example, discloses that the hot melt film (in the form of a sheet or cut to shape) may be any thermosetting film.

In addition, the specification of the present application clearly teaches that in one embodiment, the present invention may be a continuous process configuration, wherein “...rolls 308 and 312, respectively, are provided for the preformed permanent adhesive film 14 and the preformed backing film 104. Preferably, each of the adhesive film and backing film 104 are calendered,

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extruded, or coextruded films.” *See* Specification, page 22, line 22 to page 23, line 2 (Emphasis added). Elsewhere, at page 18, lines 14-20, the specification discloses that adhesive 14 is preferably a hot melt thermoplastic and/or a thermoset adhesive. Therefore, there is ample support in the specification that the adhesive film includes a thermosetting adhesive and that the thermosetting adhesive film and backing film are each a cast and/or extruded, continuous film

Moreover, the Applicant directs the Examiner to original Claim 8 of the present application. Claim 8 as originally filed recited:

The method of Claim 1, wherein the permanent adhesive layer and backing films are each a cast and/or extruded, continuous film.

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *See* MPEP 2363.06; *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Applicant has amended the specification above at page 22, line 10 to include the following sentence: “In one embodiment, the permanent adhesive layer and backing film are each a cast and/or extruded, continuous film.”

In view of the above, there is ample support for Claim 34. Applicant thus requests the rejection of Claim 34 under 35 U.S.C. 112 be withdrawn.

#### Claim 35

Claim 35 was rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Amended Claim 35 requires that the flocked regions and backing film of the molded article are each not a fabric. At page 22, line 10, the specification recites that “[t]he backing film is preferably nonwoven and neither a textile nor a fabric.” At page 19, lines 16-18, the specification that the flock 12 may be or PET, for example, and thus is not a fabric. As shown in Fig. 5 and set forth on page 26, lines 5-6, in one embodiment, the flocked molded article

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includes a film backing, adhesive layer 14, flock 12, and solidified resin 6, none of which are a fabric. Accordingly, there is ample support for amended Claim 35 in the specification. Applicant thus requests the rejection of Claim 35 under 35 U.S.C. 112 be withdrawn.

Claim 37

Claim 37 was also rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. According to the Examiner, the specification as originally filed does not support the claim limitation “wherein the mold insert comprises a flocked area surrounded at least substantially by an unflocked area of the backing film.” Applicant respectfully disagrees with the Examiner’s position. At page 27, lines 12-16, the specification recites: “In one configuration, flock 8 (an optionally release adhesive) are located in only a central section 900 of the backing film 104 while the outer periphery is free of flock. This configuration is shown in Fig. 9.” (Emphasis added). Accordingly, there is express support for the limitation, “wherein the mold insert comprises a flocked area surrounded at least substantially by an unflocked area of the backing film” in the specification. Therefore, Applicant requests the rejection of Claim 37 under 35 U.S.C. 112 be withdrawn.

Claim 46

Claim 46 was rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. The Examiner contends the term “nonwoven” is used in the specification to refer to a film-like material (i.e. not a textile or fabric) while the accepted meaning of nonwoven is limited to textile materials (i.e comprising fibers), such as fabrics. The Examiner concludes that the term is indefinite because the specification does not clearly redefine the term. Applicant respectfully disagrees with the Examiner’s position.

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At page 22, lines 10-13, the specification states that “[t]he backing film is preferably nonwoven and neither a textile nor a fabric. Preferably, the backing film is in the form of a cast or extruded film.” It appears the Examiner is incorrectly interpreting the sentence stating that in one embodiment, “the backing film is in the form of a cast or extruded film” to be inextricably linked to its preceding sentence (which states that the backing film is preferably nonwoven and neither a textile nor a fabric). In fact, however, the sentences may be read and interpreted separately. Thus, in one embodiment, the backing film may be simply nonwoven as would be understood by one skilled in the art. In another embodiment, the backing film may also be or alternatively is neither a textile nor a fabric. In yet another embodiment, the backing film may also be or alternatively is, in the form of a cast or extruded film. In other words, the sentence disclosing the embodiment, wherein the backing film is in the form of a cast or extruded film does not further limit or clarify the preceding sentence (stating that the backing film is preferably nonwoven and neither a textile or a fabric). Thus, the disclosure that the backing film is nonwoven may stand on its own and there is ample support in the specification, that in one embodiment, the backing film is “nonwoven” as the term is generally understood by one skilled in the art. Accordingly, Applicant requests that the rejection of Claim 46 under 35 U.S.C. 112 be withdrawn.

Based upon the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

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Respectfully submitted,

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